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| 10/691,799      | 10/21/2003  | Andrew C. Kesling    | 815-1062.CIP        | 6659             |

7590 06/13/2006

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| EXAMINER |
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LEWIS, RALPH A

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| ART UNIT | PAPER NUMBER |
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3732

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/691,799

Applicant(s)

KESLING, ANDREW C.

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **Objections to the Specification**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification provides no apparent basis for the in/out compensation “standard value” of claim 8. It is unclear what constitutes the “standard value” or where it is defined.

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, applicant's use of the terms “horizontally” (line 3) and “mesiodistally” (line 5) to apparently reference the same direction is confusing. Consistent terminology throughout the claims is required.

In claim 8, it is unclear what constitutes “an in/out compensation value other than the standard value.” It is unclear where or how the “standard value” is ever defined. One could never know whether or not a particular bracket meets the limitation of the claim as the “standard value” is never defined.

### Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,746,242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims of '242 set forth an orthodontic bracket with first and second layers of cured and uncured polymer resin of the same family. In regard to the limitation that the bracket or first layer being configured to coact with the archwire slot to produce a in/out compensation value that is not "the standard value", the examiner is of the firm position that the patented '242 bracket inherently produces such a value, whether the value is recognized in the prior patent is of little consequence in the apparatus claims.

Claims 1 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,746,242 in view of Kesling (US 5,813,853). The patented claims of '242 teach an orthodontic bracket having a base comprised of first and second layers of polymer resins wherein the first layer is cured and the second layer is uncured. The claims of '242 fail to teach making the first cured base layer of uneven thickness in order to provide for rotation or torque. Kesling '853, however, discloses an orthodontic bracket 26 having an archwire slot 31 wherein the bracket is attached to a base 10 which may be of plastic (column 2, line 18 - i.e. "a cured polymer resin") and which has an uneven thickness which can be arranged mesiodistally to provide rotation (Figure 6) or occlusogingivally to provide torque (Figures 3-5). To have provided the claimed '242 bracket with an uneven first layer so that the bracket can cause rotation or torque as taught by Kesling '853 would have been obvious to one of ordinary skill in the art.

Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,746,242 in view of Damon (US 6,071,118). The patented claims of '242 teach an orthodontic bracket having a base comprised of first and second layers of polymer resins wherein the first layer is cured and the second layer is uncured. The claims of '242 fail to teach making the bracket nonaligned with the base in order to provide for tipping. Damon, however, discloses an orthodontic bracket wherein the bracket body 19 is nonaligned with the base 10 in order to provide for "tipping" (column 5, line 9). To have nonaligned the

claimed '242 bracket with its base in order to provide for tipping as is taught by Damon would have been obvious to one of ordinary skill in the art.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Wong (US 5,810,584).

Wong discloses an orthodontic appliance having a first cured polymer layer ("Paste A", column 3, lines 16-56) and a second uncured polymer resin layer ("Paste B", column 3, lines 58 – column 4, line 50). In regard to the "substantially the same family" limitation, polymer resins of Wong are both from the family of dental adhesives. In regard to the limitation that the bracket or first layer being configured to coact with the archwire slot to "produce an in/out compensation value other than the standard value," the examiner is of the firm position that the Wong bracket inherently produces a value which is not "standard" to someone, whether the value is recognized in the prior patent is of little consequence in the apparatus claims. And old and known device does not become patentable merely because an applicant recognizes some new property that old and known device inherently possesses.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kesling (US 5,813,853) in view of Wong (US 5,810,584).

Kesling '853 discloses an orthodontic bracket 26 having an archwire slot 31. The bracket is attached to a base 10 which may be of plastic (column 2, line 18 - i.e. "a cured polymer resin") and which has an uneven thickness which can be arranged mesiodistally to provide rotation (Figure 6) or occlusogingivally to provide torque (Figures 3-5). Kesling '853 fails to disclose the claimed "second layer of uncured polymer resin." Wong, however, teaches that it is desirable to provide dental orthodontic brackets with a factory pre-applied uncured polymer adhesive layer in order for the clinician to save time in preparing the brackets for installation (column 1, line 26). To have preapplied an uncured polymer adhesive resin to the base 10 of Kesling '853 in order to save the clinician time as taught by Wong would have been obvious to one of ordinary skill in the art. In regard to the "same family" limitation is noted that polymers used in dentistry belong to the same dental polymer family.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Damon (US 6,071,118) in view of Wong (US 5,810,584).

Damon discloses an orthodontic bracket wherein the bracket body 19 that is nonaligned with the base 10 in order to provide for "tipping" (column 5, line 9). The bracket base may be made of plastic (column 5, line 19 - i.e. "a cured polymer resin"). Damon fails to disclose the claimed "second layer of uncured polymer resin." Wong, however, teaches that it is desirable to provide dental orthodontic brackets with a factory pre-applied uncured polymer adhesive layer in order for the clinician to save time in preparing the brackets for installation (column 1, line 26). To have preapplied an uncured polymer adhesive resin to the base 10 of Damon in order to save the clinician time as taught by Wong would have been obvious to one of ordinary skill in the art. In regard to the "same family" limitation is noted that polymers used in dentistry belong to the same dental polymer family.

#### **Response to Applicant's Remarks**

Applicant's remarks have been carefully considered and reviewed, however, are deemed moot in light of the new grounds of rejection and cited art.

#### **Action Made Final**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP




§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis  
June 9, 2006

  
**Ralph A. Lewis**  
**Primary Examiner**  
**AW3732**